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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,341	08/04/2005	Shoichi Terui	OS 050105/USA	1959
7590 04/29/2008				
Roth & Goldman Suite 707 523 West 6th Street Los Angeles, CA 90014			EXAMINER MATTER, KRISTIN CLARETTE	
			ART UNIT 3771	PAPER NUMBER
			MAIL DATE 04/29/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/521,341

**Applicant(s)**

TERUI, SHOICHI

**Examiner**

KRISTEN C. MATTER

**Art Unit**

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on 7/15/2002 and 7/15/2003. It is noted, however, that applicant has not filed a certified copies of the JP 2002-24249771 and JP 2003-305418 applications as required by 35 U.S.C. 119(b). Accordingly, the claimed priority date has not been awarded.

#### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

In the instant case, "information which is material to the examination...1.56(a)" should be changed to --information which is material to patentability...1.56--.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "2" and "10" have both been used to designate the handle and "6" and "9" have both been used to designate the casing.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “1” has been used to designate both bone and transfer and “2” has been used to designate both bone and handle.

In addition, the drawings are objected to because of the following examples of other defects:

The hand-written labels are hard to read (i.e., the “n” looks like an “m”).

Reference characters should not be underlined unless they indicated a surface or cross-section in which they are placed (i.e., lead lines should be used).

A reference character and written out definition of the element should not be used to indicate the same part in the figure simultaneously (i.e., reference characters “bone 1”, “bone 2”, “11 safety guard”, “12 back of head”, “20 safety member”, “transfer 1”, etc. make it hard to tell if the reference character is one or two reference characters indicating one or two separate elements).

In order for the table (Figure 9) to be in the drawings, the table must also be included in the specification for applications filed under 35 USC 371.

Figure 12 appears to be four (4) separate figures that should each be given their own figure number, otherwise a bracket or other connection means must clearly be shown indicating how the separate elements are connected.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Please note that the above are merely examples of the defects found in the drawings because the defects are too numerous for the examiner to independently indicate each single one.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant case, the abstract should be in single paragraph form.

The specification is replete with grammatical errors. Examples of some grammatical errors in the specification are:

On page 1, line 19, "method" should be changed to --methods--.

On page 3, line 12, "skins" should be changed to --skin--.

On page 3, line 19, "get smooth and are strengthened" should be changed to --gets smooth and is strengthened--.

On page 4, line 11, "get" should be changed to --gets--.

On page 9, line 8, it appears "safety member 2" should be changed to --safety member 20--.

On page 10, complete sentences should be used in the industrial usability section.

In addition, throughout the specification reference is made to specific claims (i.e., "As cited in claims..." or "Claim...relates to Figure..."). All such reference to the claims must be deleted from the specification.

Please note that the above are merely examples of the defects found in the specification because the defects are too numerous for the examiner to independently indicate each single one.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation.

Regarding claims 1 and 9, a single means claim is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph (see *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983)) because a single means claim covers every conceivable structure for achieving the stated purpose while the specification discloses at most only those means/structures known to the inventor. Therefore, one of ordinary skill in the art would not be able to make the instant invention using the disclosure alone without undue experimentation.

Claims 2-5 and 10-14 are dependent on claim 1 and are therefore rejected for the same reasons outlined above with respect to claim 1.

Regarding claims 6 and 7, applicant gives no insight on how or why the transfer is installed/provided at a cell phone (i.e., is the transfer part of the cell phone?, is the transfer attached by removable mechanical means?, etc.). One of ordinary skill in the art would not be able to make the instant invention using the disclosure alone without undue experimentation.

Regarding claim 8, applicant gives no insight in the specification what eyesight can be achieved or how the glasses are changed to a lower power in the specification (i.e., are there two separate glasses?, what is done to change the glasses and eyesight?, etc.). One of ordinary skill in the art would not be able to make the instant invention using the disclosure alone without undue experimentation.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no discussion in the specification about how eyesight is enhanced, what is meant by "previous eyesight", or what the low power glasses are.

Claim 8 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth below, one skilled in the art clearly would not know how to use the claimed invention. For example, claim 8 claims to restore eyesight to a previous eyesight but gives no disclosure as to how eyesight is enhanced or how the low power glasses are able to enhance the eyesight (in addition, applicant gives no disclosure as to what the low power glasses are structurally).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-10, and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



Regarding claims 7 and 9, it is not clear what is meant by a “repulsive force.” Is this a mechanical force, magnetic force, etc.? As disclosed in the specification it appears that every conceivable force can be labeled a repulsive force.

Regarding claim 8, it is unclear what is meant by the term “previous eyesight” (i.e., previous to what event?).

Claim 10 recites the limitation “circulating transfer having a stabilization weight” in lines 1-2. There is insufficient antecedent basis for this limitation in the claim because the circulating transfer was not previously claimed as having a stabilization weight.

Regarding claims 12 and 13, the terms “get longer”, “get shorter”, “get higher”, and “get lower” are unclear because it appears as though the transfer are actually growing or shrinking in length, but from the drawings it appears as though applicant is referring to some transfer members being shorter than others. In addition, it is unclear what “the same” is referring to in lines 2-3 of both claims (i.e., both sides of the same what?).

Regarding claim 14, the lengths of the transfers are unclear because applicant appears to be defining the length by terms of a user’s dimensions. The terms “to match with the upper side of the head,” for example, give no definite indication as to how long the transfers are because a user’s head dimension would change for each individual user plus it is unclear as to what part of a head is being referred to (i.e., circumference).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-7 and 9-14 positively claim human body parts (i.e., "presses a portion needing therapy"). Examiner suggests adding "adapted to" language to the claim to avoid claiming non-statutory subject matter.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility as discussed in the above section (i.e., restoring eyesight by apparently massaging the eye and then wearing glasses).

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 9-11, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Bodline (US 3,563,233). Bodline discloses a massaging apparatus with a circulating transfer (23) of which one side is fixed to a motor (15) for pressing on a portion needing therapy (see abstract). The device includes a stabilization weight (Figure 3) and the force/inertia generated by the motor to drive the shaft and applicator (23) is considered a repulsive force. What portion of the user the device presses is considered intended use and therefore not given much patentable weight. The device disclosed by Bodline is fully capable of pressing on any portion of a user's body that is claimed.

Claims 1-5 and 9, and 11-14, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Bellandi (US 5,447,491).

Regarding claims 1-5 and 9, and 11, Bellandi discloses a massaging apparatus with a plurality of circulating transfers (11) of which one side is fixed (Figure 1) driven by a motor (12) for pressing on a portion needing therapy (see abstract). The force/inertia generated by the motor to drive fingers (11) is considered a repulsive force. What portion of the user the device presses is considered intended use and therefore not given much patentable weight. The device disclosed by Bellandi is fully capable of pressing on any portion of a user's body that is claimed.

Regarding claims 12-14, Bellandi discloses that the circulating transfers are provided in multiple numbers and that the transfers in the middle of the device are shorter than those at the outside of the device (Figure 1). The length of the transfers appears to be such that the device "matches" with the dimensions of various parts of a user's head to allow massage.

Claims 6 and 7, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US 6,560,467). Kim discloses a cell phone with a vibrator (40) and a circulating transfer (antenna) that would be fully capable of pressing a portion needing therapy. The force/inertia generated by vibrator is considered a repulsive force that would cause the antenna to vibrate as well.

Claims 8, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Maloncon (US 6,386,702). Maloncon discloses a low power glasses for use after enhancing eyesight by lasik surgery, which would help maintain the same eyesight (column 4, lines 30-35).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fiorini is cited to show circulating transfers for massaging the head, Ishii is cited to show another similar circulating transfer to those claimed, and Wahl is cited to show another massage device with multiple circulating transfers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771

/Kristen C. Matter/  
Examiner, Art Unit 3771